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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,421	09/22/2003	Jun Ikami	117227	6512

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,421

Applicant(s)

IKAMI ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/04 11/6/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-7 in the reply filed on 11 July 2005 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims 1-7 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims.. This is not found persuasive because the search for the toners of Group I requires no search for a toner with the colorant iron oxide diameters, content percents, and first and second silica additives of Group II. Similarly the search for the iron oxide particle magnetic characteristics and size relationship with respect to the toner are not required of the Group II. The searches are not coextensive and would require a serious burden on the Office if conducted in the same application.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 2, 4 and 6 are objected to because of the following informalities: the word "ion" should be "iron". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Taya *et al.* in US Patent 5,296,326 or Sakashita *et al.* in US Patent 4,952,476, Sakashita in US Patent 4,820,603, or Inoue in US Patent 4,946,755 or Matsunaga in US Patent 5,411,830.

See Taya Examples 1, 3, 4, 5, 6, 7, and 8; Sakashita '476 Examples 1, 3, and 4; Inoue Example 2; Sakashita '603 Example 1; Matsunaga at least Examples 1-10. The functional language of "used in an image-forming apparatus..." is an intended use limitation and does not provide any patentable weight to the claimed toner, which is fully described in the remainder of the claim where the composition and ratio are defined.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 423 743.

See Examples 1-3. The functional language of "used in an image-forming apparatus..." is an intended use limitation and does not provide any patentable weight to the claimed toner, which is fully described in the remainder of the claim where the composition and ratio are defined.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 1 241 530.

See Example 1, particularly page 20, lines 5-13.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi *et al.* in US Patent 2002/0031713.

Hayashi discloses a magnetic toner containing magnetic composite particles and a binder resin. Magnetite particles 2 and 5 are spherical (see Tables 1 and 2, p. 25). Magnetite

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particle 2 has a ratio of residual magnetization to saturation magnetization of 0.0896 (Table 1, p. 25) while Magnetite particle 5 has a corresponding ratio of 0.0885. Each magnetic particle has a size of 0.22 microns (Tables 1 and 3). Toners made from these magnetic particles have sizes of 10.1 and 9.7 microns, respectively (Table 8; Examples 10 and 13, which rely on the magnetic composite particles of Examples 4 and 7 as seen in Table 7). The ratios for the magnetic particle to toner particle sizes fall within the scope of the claims. Although the retentivity of the magnetic particles is not specifically disclosed, it appears that the reference inherently has retentivities within the scope of the claims because the magnetic particles have the requisite composition (i.e., iron oxide), size, shape, and ratio of residual magnetization to saturation magnetization taught by the instant specification. Given each of these similarities it appears that the retentivity would also be within the scope of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi *et al.* in US Patent 2002/0031713.

Hayashi was discussed above. The reference does not appear to specifically disclose the volume percent of the iron oxide particles with respect to the toner. However, Hayashi teaches that the amount of the binder resin is from 50 to 900 parts by weight while the magnetic

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particles are present in an amount of 100 parts by weight and the blue pigment particles are 1 to 50 parts by weight ([0284], [0298]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the amount of the magnetic particles in the toner within the general disclosure of the reference in order to form an effective toner according to the reference's teachings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdr
8 August 2005

**CHRISTOPHER RODEE
PRIMARY EXAMINER**